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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6
7

8 *Ex parte* CARL SELF, CYNTHIA TAAFFEE, GORDON LOUIS
9 HOPCIAN, JEFF IANNUZZI, JULIE TROSEN, and ROD WENDEL
10

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12 Appeal 2009-006697
13 Application 10/064,959
14 Technology Center 3600
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17 Decided: April 29, 2010
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21 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and BIBHU R.
22 MOHANTY, *Administrative Patent Judges*.
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24 CRAWFORD, *Administrative Patent Judge*.
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26

27
DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented online systems and methods for facilitating improvements in the consistency, deliverability, and/or measurability of launch practices (Spec. [0002]).

Independent claim 1 under appeal reads as follows:

1. An online method for facilitating improved consistency, deliverability and/or measurability of a launch practice utilized in a product development launch cycle across a first launch program team during a first launch program and a second launch program team during a second launch program, the online method comprising:
determining a launch practice item based on a set of key sources, wherein the launch practice item is determined by a committee separate from the first and second launch program teams;
transmitting the launch practice item to an at least one member of the second launch program team; and
the at least one member of the second launch program team using the launch practice item to improve consistency, deliverability and/or measurability of the launch practice during the second launch program.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Jordan Kogler	US 2003/0040998 A1	Feb. 27, 2003
Linde	US 2003/0105773 A1	Jun. 5, 2003
Bieda	US 2003/0171897 A1	Sep. 11, 2003

The Examiner rejected claims 1-10, 19, and 20 under 35 U.S.C. § 101 for failing to recite statutory subject matter; rejected claims 1-2 and 6-20 under 35 U.S.C. § 103(a) as being unpatentable over Linde in view of Bieda; and rejected claims 3-5 under 35 U.S.C. § 103(a) as being unpatentable over Linde in view of Bieda and Jordan Kogler.

We AFFIRM.

ISSUES

Did the Examiner err in asserting that claims 1-10, 19, and 20 do not recite statutory subject matter under 35 U.S.C. § 101?

Did the Examiner err in rejecting claims 1-20 as being unpatentable under 35 U.S.C. § 103(a) over various combinations of references including Linde and Jordan Kogler, because Linde and Jordan Kogler are non-analogous art to the claimed invention?

Did the Examiner err asserting that a combination of Linde and Bieda renders obvious the subject matter of independent claim 11?

Did the Examiner err asserting that a combination of Linde and Bieda renders obvious “the launch practice item is selected from the group consisting of launch elements, procedures, guidelines, standards, policies, and work instructions,” as recited in dependent claims 12 and 16?

Did the Examiner err asserting that a combination of Linde and Bieda renders obvious “the launch practice item is a procedure and a document supporting the procedure includes measurables and deliverables,” as recited in dependent claims 13 and 17?

Did the Examiner err asserting that a combination of Linde and Bieda renders obvious “the launch practice item is a standard and a document

supporting the standard includes information regarding how the launch practice should be performed,” as recited in dependent claims 14 and 18?

FINDINGS OF FACT

Specification

Appellants invented online systems and methods for facilitating improvements in the consistency, deliverability, and/or measurability of launch practices ([0002]).

An object of the present invention is to provide a mechanism for launch program members to make observations that are integrated into existing launch practices if integration improves the consistency, deliverability, and/or measurability of launch practices ([0007]).

Appellants’ invention is directed towards a quality management system for use during a product development launch cycle (App. Br. 5-6, 16-18).

Linde

Linde discloses:

It is desirable for companies to monitor and process information as regards the market situation for a particular product in a more effective manner. In particular, there is a desire for obtaining information related to a pre-launch strategy of a product, in terms of complete and correct pre-launch decisions, in order to determine the post-launch performance of the product on its relevant markets. In this manner, the post-launch performance and consequently also the success of the product can be expected to be optimized ([0010]).

1 When a company intends to launch a product, a number of decisions
2 have to be taken. The total number of possible decision combinations which
3 influence the post-launch success of the product can be substantial, which
4 means that it is difficult to take the correct decisions for a product launch. In
5 particular, there is difficulty in determining which combination of decisions
6 will render the highest number of patients for the product, i.e., the highest
7 impact on the relevant markets ([0011]).

8 Any form of business, in the form of a manufacturer, research center,
9 marketing agency, department store or similar enterprise, may use the
10 invention in a suitable manner in order to obtain information related to the
11 post-launch success of a particular product. In this manner, the invention
12 can be used in order to meet certain desired business objectives including
13 incremental sales and obtaining increased market shares for the product
14 ([0027]).

15 For the purpose of understanding the present invention, a number of
16 key ““success factors”” for obtaining improved market performance of a
17 product, such as a medical drug, will now be described. The invention relies
18 on the insight that such key success factors are crucial for the expected
19 future sales of the product in question, and also for the possibilities of
20 processing, presenting, and transmitting relevant information regarding the
21 market situation of a drug and for the quantification of the post-launch
22 performance ([0032]).

23 This set of information is normally provided by a service provider
24 such as a medical marketing company, and is supplied, in accordance with

1 the invention, to a client which normally is in the form of a medical
2 company, a drug manufacturer, a research center, or a similar enterprise
3 ([0033]).

4 It can be noted that the key success factors provide transparency of a
5 market for fast understanding, benchmarking, forecasting, and strategic
6 decision-making. By means of the key success factors, the structure,
7 dynamics, and trends on a particular market for a particular drug and/or
8 disease can be studied and analyzed. As will be described in greater detail
9 below, the result of such a process can then easily be stored for subsequent
10 transmission to a client ([0034]).

11 A quantification of the future, i.e., post-launch, performance on the
12 market of the drug can then be estimated based on three types of
13 information: i) market information including, for example, data about the
14 number of patients which enter the system per month and per physician, ii)
15 information related to the unmet needs on the market, quantified in terms of
16 the proportion of physicians for which such unmet needs are relevant, and
17 iii) information related to the propensity to prescribe a particular drug,
18 quantified in terms of the proportion of physicians who would prefer the
19 drug instead of competing drugs ([0076]-[0079]).

20 The calculation of the post-launch performance will now be described
21 with reference to Figure 6 ([0080]-[0081]).

22 A client may obtain the finished result, i.e., the information regarding
23 the marketing parameters described above, in various ways ([0085]).

24 The client can be a medicine manufacturer, a research center, or even
25 an advertising agency, who then may use the principles according to the
26 invention in order to gain access to valuable marketing information. In

1 particular, the information which can be provided by means of the invention
2 can be used for benchmarking of various products, for example on different
3 markets or during specific time periods ([0087]).

4
5 *Bieda*

6 Bieda discloses that its present method and apparatus provides an
7 understanding of the total cost of quality as well as the quality cost
8 components. These costs as well as the stored lessons learned from each
9 complete product development are stored for future use. This simplifies
10 future product development programs by enabling quality issues to be
11 shifted to the design and process development stage rather than later in the
12 product prototype development or field use stages ([0025]).

13
14 *Jordan Kogler*

15 Jordan Kogler discloses:

16 A system and method of direct marketing of secondary products
17 through channels opened by the direct marketing of primary products,
18 thereby acquiring new customers for the secondary product (Abstr.).

19 The marketing agent 410 uses the customer information and customer
20 lists of the customer data to generate, revise, evaluate, or the like, the
21 marketing strategy, market penetration, market demographics, and the like,
22 of the credit card company 420. The marketing agent 410 may analyze the
23 customer data and customer lists to gain knowledge of which product offers
24 garner more customer acceptance. The marketing agent may refine the
25 customer offers based on information from previous offers to increase
26 product acceptance. Additionally, the marketing agent 410 may analyze the

customer data to determine which, if any, second product extensions may be offered. These aforementioned additional analyses may be iterative processes with further refinement as more data is collected ([0069]).

PRINCIPLES OF LAW

Statutory Subject Matter

The test to determine whether a claimed process recites patentable subject matter under § 101 is whether: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir. 2008) (en banc).

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *Ex parte Langemyr*, 89 USPQ2d 1988, 1996 (BPAI 2008) (Informative) (*citing Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972)).

The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. *Bilski*, 545 F.3d at 961 (Fed. Cir. 2008), *cert. granted*, 129 S. Ct. 2735 (2009) (*citing Benson*, 409 U.S. at 71-72).

Whether a claim is drawn only to a fundamental principle is essentially an inquiry into the scope of that exclusion; i.e., whether the effect of allowing the claim would be to allow the patentee to pre-empt substantially all uses of that fundamental principle. If so, the claim is not drawn to patent-eligible subject matter. *In re Bilski*, 545 F.3d at 953 (*citing Diamond v. Diehr*, 450 U.S. 175, 185, 187 (1981)).

Non-Analogous Art

The test for determining whether a reference is analogous art is (1) whether the reference is in the field of the Appellants' endeavor or (2) whether the reference is reasonably pertinent to the problem with which the Appellants were concerned. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Obviousness

Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 703 F.2d 1381, 1385-86 (Fed Cir. 1983).

ANALYSIS

Statutory Subject Matter

We are not persuaded that the Examiner erred in asserting that claims 1-10, 19, and 20 do not recite statutory subject matter under 35 U.S.C. § 101 (Exam'r's Ans. 3; Reply Br. 2-3). As an initial matter, independent claim 1 does not meet the second prong of the machine-or-transformation test

1 because no transformation, even of data, occurs. *See In re Bilski*, 545 F.3d
2 at 961-62.

3 Regarding the first prong, Appellants assert that the recitation in
4 independent claim 1 of an “online method” and “transmitting” is “more than
5 purely mental steps,” and thus are sufficiently tied to a machine to be
6 statutory subject matter (Reply Br. 2). However, the recitations of “online
7 method” and “transmitting,” while insinuating the use of a machine, do not
8 in and of themselves recite a machine. Moreover, even if they did
9 sufficiently recite a machine, the machine amounts to no more than a general
10 purpose computer, which is insufficient to impart patentability, as a general
11 purpose computer is not a “particular machine” as required by *Bilski*. *See Ex*
12 *parte Langmyr*, 89 USPQ2d at 1996.

13 The same analysis is applied to “updating an at least one server
14 computer” recited in dependent claim 5 (Reply Br. 3). The “at least one
15 server” computer is a general purpose computer insufficient to impart
16 patentability to the method of claim 5.

17 Furthermore, even if independent claim 1 is taken as performing
18 online transmitting via a particular computer, such a recitation of structure
19 does not impose meaningful limits on the claim, because any online
20 transmitting must be performed via a computer. Thus, the implicit recitation
21 of a computer in the online transmitting step is not, in fact, a limitation at all
22 to the scope of the claim, and the claim is directed, in essence, to the online
23 transmitting step performed by any means. *See Bilski*, 545 F.3d at 953, 961.
24 Such a method claim, where a recited structure does not impose meaningful
25 limits, is not drawn to patent-eligible subject matter. *See Id.*

Except as set forth herein, we do not reach the merits of the prior art rejections of claims 1-10, 19, and 20 of our decision because we have determined that the aforementioned claims on appeal do not recite patent-eligible subject matter under § 101. We do not reach these rejections. *See Diehr*, 450 U.S. at 188; *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (declining to reach an obviousness rejection on appeal after concluding many claims were non-statutory under § 101); *Bilski*, 545 F.3d at 951 n.1 (noting that § 101 is a threshold requirement and that the Examiner may reject claims solely on that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it unnecessary to reach rejection based on prior art after concluding claims were directed to nonstatutory subject matter); *Ex Parte Gutta*, 93 USPQ2d 1025, 1036 (BPAI 2009) (per curiam) (expanded panel) (precedential) (as the claims on appeal do not recite patent-eligible subject matter under § 101, the prior art rejections need not be considered).

Non-Analogous Art

We are not persuaded that the Examiner erred in asserting that claims 11 to 18 are unpatentable under 35 U.S.C. § 103(a) over various combinations of references including Linde and Jordan Kogler, because Linde and Jordan Kogler are non-analogous art to the claimed invention (App. Br. 4-8, 16-18). Concerning Linde, Appellants' invention is directed towards a quality management system for use during a product development launch cycle (App. Br. 5-6, 16-18). Linde is directed towards optimizing pre-launch procedures to maximize post-launch success ([0010]-[0011]). Accordingly, Appellants' invention and Linde are both directed to the same problems of optimizing the pre-launch product development cycle, and thus

meet the second prong of the analogous arts test. *See In re Oetiker*, 977 F.2d at 1447.

Concerning Jordan Kogler, Appellants' invention is directed to providing a mechanism for launch program members to make observations that are integrated into existing launch practices if integration improves the consistency, deliverability, and/or measurability of launch practices ([0007]). Jordan Kogler discloses analyzing customer data and lists to generate, revise, evaluate, or the like, the marketing strategy, market penetration, market demographics, and the like ([0069]). Accordingly, Appellants' invention and Jordan Kogler are both directed to analyzing and incorporating data to improve deliverables, and thus also meet the second prong of the analogous arts test. *See In re Oetiker*, 977 F.2d at 1447. We note that the problem solved does not need to be the *primary* problem set forth by either Appellants' invention or the reference; *any* problem will suffice.

Independent Claim 11

We are not persuaded that the Examiner erred asserting that a combination of Linde and Bieda renders obvious the subject matter of independent claim 11 (App. Br. 14-16). Linde discloses “during the first launch program, transmit a launch practice item to an at least one member of the first launch program team, wherein the at least one member uses the defined launch practice item to improve consistency, deliverability and/or measurability of the launch practice” (Exam'r's Ans. 29). Current drug data is used to benchmark future drugs. This data is transmitted from the medical marketing company to the “manufacturer,

research centre, marketing agency, department store or similar enterprise” set forth in paragraph [0027]. Increased data makes benchmarking more accurate, which improves at least measurability.

Bieda discloses that at least one server computer is configured to “receive an at least one member observation regarding the launch practice item from the at least one member of the first launch program team” and “transmit a revised launch practice item and/or a new launch practice item implementing the at least one member observation . . . if implementing the observation improves the consistency, deliverability and/or measurability of the launch practice” (Exam’r’s Ans. 29-31). Bieda discloses that lessons learned are collected by one team and stored for future use by another team ([0025]). The lessons learned correspond to both the recited observations and revised launch practice item. The storing of the lessons learned between the collection by the first team and use by the later team is a transmission under a broadest reasonable construction. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364.

Launch Practice Item

We are not persuaded that the Examiner erred asserting that a combination of Linde and Bieda renders obvious “the launch practice item is selected from the group consisting of launch elements, procedures, guidelines, standards, policies, and work instructions,” as recited in dependent claims 12 and 16 (App. Br. 10-12). The Examiner cites the data collection, calculation, and presentation to the client of post-launch performance and marketing parameters in paragraphs [0076]-[0081], [0085] of Linde (Exam’r’s Ans. 26-27). At least procedures, guidelines, standards,

1 and work instructions were utilized to collect and calculate the data to arrive
2 at the output presented to the client. Furthermore, paragraph [0087] of
3 Linde discloses benchmarking, which is a standard. Moreover, all of the
4 referenced launch practice items are printed matter. *See In re Gulack*, 703
5 F.2d at 1385-86.

6
7 *Measurables and Deliverables*

8 We are not persuaded that the Examiner erred asserting that a
9 combination of Linde and Bieda renders obvious “the launch practice item is
10 a procedure and a document supporting the procedure includes measurables
11 and deliverables,” as recited in dependent claims 13 and 17 (App. Br. 12-
12 13). The Examiner cites the data collection, calculation, and presentation to
13 the client of post-launch performance and marketing parameters in
14 paragraphs [0076]-[0081], [0085] of Linde (Exam’r’s Ans. 26-27).
15 Procedures were utilized to arrive at the “measurables and deliverables”
16 presented to the client concerning post-launch performance and marketing
17 parameters. Moreover, procedures and their associated documents are
18 printed matter. *See In re Gulack*, 703 F.2d at 1385-86. Specifically, the
19 contents of procedures and their associated documents are merely data that
20 does not change the operation of any underlying apparatus; they do not
21 include code used to operate such an apparatus. Thus, these data contents
22 could be interchanged for other data contents without changing the operation
23 of the underlying claimed computer system. Accordingly, varying the
24 contents of these documents in such a manner is obvious.

1 *Standard*

2 We are not persuaded that the Examiner erred asserting that a
3 combination of Linde and Bieda renders obvious “the launch practice item is
4 a standard and a document supporting the standard includes information
5 regarding how the launch practice should be performed,” as recited in
6 dependent claims 14 and 18 (App. Br. 13). The Examiner cites paragraph
7 [0034] of Linde as disclosing that key success factors are necessary to
8 provide transparency of a market for fast understanding, benchmarking,
9 forecasting, and strategic decision making (Exam’r’s Ans. 28).
10 Quantification of the key success factors is measured, via a defined process,
11 against benchmarks or standards to understand how the market will play out
12 for a particular drug. Moreover, standards and their associated documents
13 are printed matter. *See In re Gulack*, 703 F.2d at 1385-86.

14
15 **CONCLUSION OF LAW**

16 The Examiner did not err in rejecting claims 1-20.

17
18 **DECISION**

19 The decision of the Examiner to reject claims 1-20 is affirmed.

20 No time period for taking any subsequent action in connection with
21 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
22 § 1.136(a)(1)(iv) (2007).

23
24 **AFFIRMED**

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6 BROOKS KUSHMAN P.C./FGTL

7 1000 TOWN CENTER

8 22ND FLOOR

9 SOUTHFIELD, MI 48075-1238